

### REMARKS

Reconsideration and allowance of the above identified patent application are hereby requested. Claims 1-4, 6, 8-18, and 27-35 remain pending, with claims 1, 18, 27, and 34 being independent. Claims 5, 7, and 19-26 were previously canceled. The Office (Action of August 3, 2009 at page 2) indicates that "The indicated allowability of claim 7 is withdrawn in view of the newly discovered reference Jiang et al. ..." The Office's new rejections are respectfully traversed.

### **Rejection Under 35 U.S.C. § 103**

The Office states that (Action of August 3, 2009 at page 3) "claims 1, 4-6, 8-10, 13-14, and 16-17" stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Detlef (U.S. Patent No. 6,351,523) in view of Jiang et al. (U.S. Patent No. 7,092,370). However, it is noted that the Office sets forth grounds for rejection of claims 1-4, 6, 8-18, and 27-35 based on these references. Further, it is noted that Jiang et al. was filed on August 16, 2001, which is after the June 18, 2001 filing date of the present application. The Office has not established that Jiang et al. is entitled to the benefit of an earlier filing date by demonstrating that the subject matter upon which the Office relies was fully supported under the first paragraph of 35 U.S.C. § 112 by the provisional application. *See* MPEP § 2136.03. Therefore, the Office's reliance on Jiang et al. is improper. The Office's contentions are respectfully traversed.

### Claim 1

Claim 1 recites (emphasis added) "...communicatively connecting to a first server over the wireless communications network; receiving input from the user selecting an option presented by the first server to send the audio file to the email recipient; terminating the

connection with the first server and establishing an audio connection between the wireless communication device and a second server over the wireless communications network in response to the selected option, wherein the first server transmits a signal to the second server indicating a pending connection with the wireless communication device, the signal including information identifying the wireless communication device; recording the audio file on the second server; and sending the recorded audio file to the email recipient as part of an email message;....”

The Office asserts (Action of August 3, 2009 at page 3) that Detlef discloses (emphasis added) “Establishing an audio connection between the wireless communication device and a second server (i.e. IFW; Figure 1-item 26) over the wireless communications network in response to the selected option, (i.e. voice reply to email; column 4, lines 23-40).” The Office further asserts (*Id.* at page 4) that Detlef discloses (emphasis added) “Recording the audio file on the second server (i.e. voice memo function recorded onto voicemail system column 3, line 67-column 4, line 6; column 4, line 62-column 5, line 7).” Detlef fails to disclose the claimed subject matter.

Detlef does not disclose establishing an audio connection with a second server. The Office (Action of August 3, 2009 at page 3) asserts that the inter-working function (IWF) 26 represents the second server. However, the inter-working function is an interface between the cellular processing system 20 and the public switched telephone network 28. (*See, e.g.*, U.S. Patent No. 5,909,648 at Col. 1, lines 19-26.) Detlef does not disclose or suggest that an audio connection can be established between a wireless communication device and the IWF. As a result, Detlef also does not disclose establishing an audio connection with the second server in

response to the selected option – namely the option presented by the first server to send the audio file to the email recipient.

Moreover, Detlef does not disclose or suggest recording the audio file on the second server, which the Office has identified as the IWE. The Office (Action of August 3, 2009 at page 4) appears to concede this point and instead refers to a “voice memo function recorded onto voicemail system.” However, the voice memo function disclosed by Detlef is not associated with a server. To the contrary, Detlef (Col. 3, line 66 – Col. 4, line 6) discloses that the voice memo function is “stand-alone” and is associated with a client device, not a server. For example, Detlef (*Id.*) states (emphasis added)...

In fact, a number of cellular phones and most PDAs, also referred to herein as ‘thin client devices,’ already offer a stand-alone voice memo function. The processing power required to convert captured audio into one of the common audio distribution file formats is minimal. Portable devices exist in the market today which contain all of the hardware elements necessary to perform this operation.

Further, the voicemail system to which the Office refers is associated with receiving an audio file, not recording an audio file. For example, Detlef discloses (Col. 4, lines 55-58; emphasis added) “The voice data file, as received in server 36, is separated from the EMail reply, and is transformed into a voice stream by a voicemail interface 42, transmitted to the voicemail system 44 and then to a PBX 46.” Detlef further explains (Col. 4, lines 63-66; emphasis added) “This server hardware/software solution allows attached voice memos to be stripped from inbound EMail and redirected to the voicemail box associated with the EMail recipient.” Thus, Detlef also does not disclose or suggest recording an audio file on the voicemail system. Accordingly, Detlef fails to disclose or suggest establishing an audio connection between the wireless

communication device and a second server over the wireless communications network in response to the selected option and recording the audio file on the second server, as recited by claim 1.

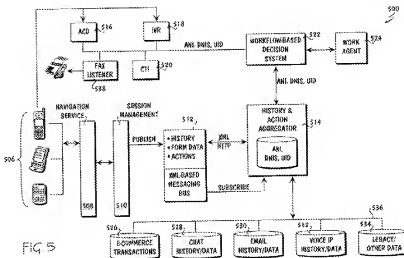
Jiang et al. do not cure the deficiencies of Detlef. For example, Jiang et al. also do not disclose or suggest establishing an audio connection between the wireless communication device and a second server over the wireless communications network in response to the selected option. As such, the Office has failed to meet its burden of establishing a *prima facie* case of obviousness. *See* MPEP §2142.

Further, claim 1 recites (emphasis added) "...wherein the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to a same state in the first server that existed prior to terminating the connection...." The proposed combination of Detlef and Jiang et al. fails to disclose the claimed subject matter.

The Office (Action of August 3, 2009 at pages 4-5) concedes that Detlef fails to disclose the claimed subject matter, but asserts that Jiang et al. disclose that a wireless communication device stores state information comprising a status of an interaction between a wireless communication device and the first server at column 7, lines 30-38. The Office (*Id.*) further asserts that Jiang et al. disclose that the stored state information allows the wireless communication device to return to the same state in the first server that existed prior to terminating the connection at column 5, lines 1-29 and column 8, lines 9-25.

As an initial matter, Jiang et al. do not disclose or suggest that a wireless communication device stores any state information. Jiang et al. (Col. 7, lines 33-38) teach that "The history and

action aggregator uses the subscription information to access a customer layer 536. The customer layer 536 includes ecommerce transactions 526, chat history/data 528, email history/data 530, voice over Internet Protocol (IP) history/data 532, and legacy and other data 534.” Jiang et al. (Col. 7, lines 5-7 and Fig. 5) teach that the history and action aggregator 514 and the customer layer 536 are part of the computer telephony integration/interactive voice response (CTI/IVR) service 500, not a wireless communications device. Thus, assuming *arguendo* that the data stored in the history and action layer and/or the customer layer is state information, which is not conceded, Jiang et al. nonetheless do not disclose or suggest that the data is stored in a wireless communications device.



Moreover, Jiang et al. do not disclose or suggest that the stored state information allows the wireless communication device to return to the same state in the first server that existed prior to terminating the connection. Jiang et al. (Col. 8, lines 17-18) teach that the CTI/IVR service “...allows a user to toggle between a voice session and a data session.” However, toggling between sessions does not disclose, expressly or inherently, that the wireless communications

device is returning to the same state in the server. Further, Jiang et al. do not disclose or suggest that the connection with the first server is terminated through toggling. To the contrary, Jiang et al. (Col. 8, lines 14-17) teach that (emphasis added) "The CTI/IVR service 500 does not require that the wireless device 506 support simultaneous voice channel and wireless data channel as long as it supports concurrent voice channel and wireless data channel. It allows a user to toggle between a voice session and a data session." Because the wireless device supports concurrent voice and data channels, the wireless device can toggle between sessions without terminating a connection. Accordingly, Jiang et al. also fails to disclose or suggest that the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to a same state in the first server that existed prior to terminating the connection, as recited by claim 1.

For at least these reasons, claim 1 is allowable over the proposed combination of Detlef and Jiang et al. Claims 2-4, 6, and 8-17 depend from claim 1 and thus are allowable based at least on claim 1.

Additionally, independent claims 18, 27, and 34 include subject matter similar to that of claim 1. Therefore, claims 18, 27, and 34 are allowable over the proposed combination of Detlef and Jiang et al. for at least the reasons discussed with respect to claim 1. Claims 28-33 depend from claim 27 and thus are allowable based at least on claim 27. Claim 35 depends from claim 34 and thus is allowable based at least on claim 34.

Claim 9

Claim 9 recites (emphasis added) “The method of claim 8, further comprising providing the user with at least one option, the option selected from the group consisting of: re-recording the audio file and canceling the recording.” Further, claim 8 recites (emphasis added) “The method of claim 1, wherein the recording the audio file comprises: providing an audio input through the wireless communication device; and storing the audio input as an audio file on the second server.” Thus, claim 9 clearly is directed to recording of the audio file.

The Office asserts that (Action of August 3, 2009 at page 12; emphasis added) “Detlef discloses the audio note taking method further comprises providing the user with at least one option, the option selected from the group consisting of: re-recording the audio file, canceling the recording (column 5, lines 1-3).” Detlef fails to disclose the claimed subject matter.

Detlef discloses (Col. 4, line 67 – Col. 5, line 3; emphasis added) “Diverting the reply to voicemail further enhances the utility of the message, as traditional voice message manipulation tools, such as play, rewind, speed-up, forward, etc., may then be applied.” The options disclosed by Detlef do not disclose or suggest either re-recording or canceling. To the contrary, the “voice message manipulation tools” disclosed by Detlef are associated with the playback of a received message, not with the recording of a message. For instance, in the preceding sentence, Detlef discloses (Col. 4, lines 63-66; emphasis added) “This server hardware/software solution allows attached voice memos to be stripped from inbound EMail and redirected to the voicemail box associated with the EMail recipient.” Thus, Detlef’s disclosure of voice message manipulation tools cannot suggest providing the user with at least one option, the option selected from the group consisting of: re-recording the audio file and canceling the recording, as recited by claim 9. Accordingly, the rejection of this claim is legally and factually deficient.

For at least these reasons, claim 9 also is allowable over the proposed combination of Detlef and Jiang et al. based on its own merits.

### Claim 13

Claim 13 recites (emphasis added) “The method of claim 1, wherein the first server comprises an email server.” Further, claim 1 recites “...communicatively connecting to a first server over the wireless communications network; receiving input from the user selecting an option presented by the first server to send the audio file to the email recipient....”

The Office (Action of August 3, 2009 at page 13) asserts that Detlef discloses that the first server comprises an email server at “Figure 1-item 36.” Detlef fails to disclose the claimed subject matter.

With respect to Fig. 1, Detlef teaches that reference numeral 36 corresponds to an email server that receives an email message that includes a voice data file. For example, Detlef discloses (Col. 4, lines 43-49; emphasis added)...

Internet 32 connects to a receiving ISP 34, which provides service to an EMail server 36, probably located at a business location. EMail server 36 includes therein an EMail-to-voicemail gateway 38, which distinguishes conventional EMail messages from those messages generated by device 12 which are intended, ultimately, to reach a recipient's voicemail box.

Detlef does not disclose or suggest that the email server 36 presents an option to send an audio file to an email recipient. Further, Detlef does not disclose or suggest that a wireless communications device connects with email server 36 over a wireless communications network. Accordingly, Detlef fails to disclose or suggest that the first server comprises an email server, as recited by claim 13.



Jiang et al. fail to cure the deficiencies of Detlef. For instance, Jiang et al. also fail to disclose receiving input from a user selecting an option presented by an email server to send an audio file to an email recipient.

For at least these reasons, claim 13 also is allowable over the proposed combination of Detlef and Jiang et al. based on its own merits.

#### Claim 17

Claim 17 recites (emphasis added) “The method of claim 1, wherein the sending the audio file to the email recipient comprises sending a hyperlink to the audio file stored on the second server.”

The Office (Action of August 3, 2009 at page 13) asserts that Detlef discloses sending a hyperlink to the audio file at “column 5, lines 13-25.” However, Detlef is silent with respect to hyperlinks, much less sending a hyperlink to an audio file. Rather, Detlef discloses (Col. 5, lines 21-23; emphasis added) “The reply includes, in the preferred embodiment, a .wav file 66, or other audio file, which is transmitted as an attachment to the reply EMail.” Thus, Detlef expressly teaches that an audio file is transmitted as an attachment, not a hyperlink to the audio file.

Further, Jiang et al. also fail to disclose or suggest that sending the audio file to the email recipient comprises sending a hyperlink to the audio file stored on the second server. Thus, Jiang et al. fail to cure the deficiencies of Detlef.

For at least these reasons, claim 17 also is allowable over the proposed combination of Detlef and Jiang et al. based on its own merits.

Claim 35

Claim 35 recites (emphasis added) "The system of claim 34, wherein the email server is further configured to receive the audio file from the interactive voice response server and transmit the audio file in association with the accessed email message."

The Office (Action of August 3, 2009 at page 15) asserts that Detlef discloses the claimed subject matter at "column 4, lines 30-45." As discussed above with respect to claim 13, the email server disclosed by Detlef receives an email message that includes an attached voice data file. For example, Detlef discloses (Col. 4, lines 43-49; emphasis added)...

Internet 32 connects to a receiving ISP 34, which provides service to an EMail server 36, probably located at a business location. EMail server 36 includes therein an EMail-to-voicemail gateway 38, which distinguishes conventional EMail messages from those messages generated by device 12 which are intended, ultimately, to reach a recipient's voicemail box.

However, Detlef does not disclose or suggest that the email server 36 transmits the audio file in association with the accessed email message, as recited by claim 35. Moreover, Detlef does not disclose or suggest that the email server 36 receives an audio file from an interactive voice response server. In fact, Detlef is silent with respect to an interactive voice response server.

Further, Jiang et al. also do not disclose or suggest that an email server is further configured to receive an audio file from an interactive voice response server and transmit the audio file in association with an accessed email message. Therefore, Jiang et al. fail to cure the deficiencies of Detlef.

For at least these reasons, claim 35 also is allowable over the proposed combination of Detlef and Jiang et al. based on its own merits.

CONCLUSION

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

In view of the above remarks, claims 1-4, 6, 8-18, and 27-35 should be in condition for allowance, and a formal notice of allowance is respectfully requested. Alternatively, a telephonic interview is respectfully requested. Please apply the one-month extension fee of \$130 and any other necessary charges or credits to deposit account 06-1050.

Respectfully submitted,

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